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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,146	02/28/2002	Robert F. Bigelow JR.	0112300-740	4138
29159	7590	11/02/2005		
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135				
EXAMINER				
MOSSER, ROBERT E				
ART UNIT		PAPER NUMBER		
3713				

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/086,146	Applicant(s) BIGELOW ET AL.	
	Examiner Robert Mosser	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/05, 8/05, 9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION



In response to the RCE filed May 2nd 2005.

Claims 1-62 are pending.

This action is non-final.

The examiner's statements of official notice in the non-final action dated January 15th, 2004 were not challenged in the proceeding reply and are now held as applicant admitted prior art accordingly.



Information Disclosure Statement

The information disclosure statements submitted 9/28/05, 8/22/05, and 8/08/05 have been considered and are attached.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 3rd, 2005 has been entered.

Affidavit under CFR 1.131

The Affidavit filed on July 17th, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Locke et al (USP 6,561,904) reference.

The Locke et al reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Additionally the applicant's remarks of on June 3rd, 2005 propose that the presented claims and those of the prior art could not claim the same invention as the claimed invention of Locke et al "require the group of possible payout multiplier varying with the respective outcomes", while asserting that the applicant's instant claims "do not require this". However this issue falls on at least two issues. On a first point, the applicant's claims do not preclude the inclusion of the above mentioned feature of Locke et al. On a second point the present claim language of claim 1, teaches selecting a multiplier from a plurality of multipliers (a group X), and on a subsequent selection selecting a "different" multiplier from the original selection thereby selecting from (a group Y wherein $Y < X$). Hence through the applicants presented claim language the

Art Unit: 3713

applicant indeed varies the size of a group of payout modifiers with the respective outcomes. For these reasons the Affidavit filed on July 17th, 2004 under 37 CFR 1.131 has been reconsidered but is ineffective to overcome the Locke et al (USP 6,561,904) reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Locke et al (USP 6,561,904) reference. The provided statement and screen shots fail to demonstrate the presently claimed functionality. The submitted exhibits demonstrate static images of a game without providing a definitive link between the program files listed and screen shots. More over there is no evidence addressing the content of the provided program files that might be considered objective evidence.

In order for the required claim elements to be sufficiently demonstrated in a reduction to practice the gaming regulation submissions outlining the functional operation of the game/gaming device in combination with the respective formuli and/or a functional copy of the game files (Dated ROM Files with a respective Windows compatible Emulator) may assist in clarifying issues surrounding an actual reduction to practice.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3713

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1, 3-4, 6, and 61-62** are rejected under 35 U.S.C. 102(e) as being anticipated by **Locke** et al (6,561,904).

Locke teaches a gaming device that comprises a plurality of reels (Fig 4); a plurality of symbols on the reels (Fig 4 & Col 4:1-5:59); a triggering event associated with at least one of the symbols or a combination of the symbols occurring on the reels (Abstract); a plurality of free spins of the reels (Abstract); a plurality of multipliers associated with the free spins of the reels (Abstract & Col 4:1-5:59); and a processor which controls the reels whereupon an occurrence of the triggering event on the reels, the processor provides the free spins of the reels to a player and determines an award, if any, to provide to the player for each free spin based upon the symbols occurring on the reels from the free spin and the multiplier associated with the free spin, wherein the multiplier changes at least once during the free spins (Abstract, Col. 1: 49-62; Col. 2:55-67; Col 4:1-5:59).

As amended Locke further teaches the selection of a multiplier from a plurality of multipliers wherein the at least a first one of the plurality of the multipliers and a second different one of the multipliers are picked during said plurality of free reel spins, and wherein the second multiplier is picked based on the first multiplier being previously

Art Unit: 3713

picked (Col 4:1-5:59). Specifically Locke et al teaches the selection of a first multiplier (Col 4:14-17) from a plurality of multipliers (Col 4:5-14) and altering further multiplier selection based on the previous multiplier selection based on the altered table probability demonstrated in column 4, lines 27-35 and column 5, lines 17-25, wherein the probability for the selection of a 1x multiplier is originally 4/11 and finally decreases to 0.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **2**, **5**, **40**, and **44** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Locke** et al (6,561,904).

Regarding claims **2** and **40**, Locke teaches the limitations of the claims as recited above. Locke is silent regarding the number of the free spins being predetermined. The inclusion of features preset/predetermined in slot machines is noted as being applicant admitted prior art. This makes it easier to predict outcomes and payouts for the gaming establishment resulting in the gaming establishment not losing excessive amounts of money. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Locke to include this feature for this reason.

Regarding claims **5** and **44**, Locke teaches the limitations of the claims as recited above. Locke is silent regarding the feature of the number of free spins being determined by the player choosing masked selections. Allowing the players to choose masked selections in a slot gaming device is noted as being applicant admitted prior art. Allowing the players to choose masked selections in a slot gaming device increases the element of surprise; thereby increasing player participation and anticipation. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Locke with the free spin feature for these reasons.

Claims **7-39**, **41-43**, and **45-60**, are rejected under 35 U.S.C. 103(a) as being unpatentable over *Locke et al* (6,561,904) in view of *Wilson, Jr. et al* (US 6,004,207).

Regarding claims **7-17**, **31-39**, **41-43**, and **45-60**, Locke teaches all the limitations of the claims as discussed above, however is silent regarding the inclusion of an incrementor symbol. In a related *Wilson, Jr. et al* teaches a slot machine with incremental pay-off multiplier (*Wilson Abstract*) that increases a multiplier by a fixed or random amount (*Wilson Abstract & Col 4:39-5:5*) to provide a significant incentive for a player to continue to play a game (*Wilson Col 1:35-51*). It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the multiplier symbol of *Wilson* as one of the symbols of *Locke* in order to provide increased excitement and anticipation of the game as taught by *Wilson*.

Further as *Locke* is noted to shift the probability of selecting higher multipliers with each successive free reel spin the presented modification would merely entail

Art Unit: 3713

altering the provided probability table of Locke to account for the possible occurrence of the incrementor symbol or alternatively introducing the appearance of an incrementor symbol as a means for ensuring a player perceives the alteration of probability.

Regarding claims **18-30**, Locke teaches all the limitations of the claims as discussed above. Locke is silent on the feature of a consolation prize. However, the awarding consolation prizes in the gaming art is noted as being applicant admitted prior art. Awarding consolation prizes provides the players with a cheerful feeling in the event of monetary losses; thereby, making the player want to play the game again and risk wagering. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate this feature into Locke for this reason.

Response to Arguments

Applicant's arguments filed August 8th, 2005 have been fully considered but they are not persuasive.

Applicant's argues that the selection of a multiplier is independent the of a previous selected multiplier on 21 of the remarks submitted August 8th, 2005. However, this argument fails as Locke clearly demonstrates that each subsequent selection of a multiplier is indeed reliant on previous selections (Col 4:14-59). Remaining issues and elements surrounding the correlation of at least claims 1, 17, 31, 39, 52, 53, 58, and 61 are addressed in the rejections presented above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM


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